

REMARKS

Claims 1-26 are pending. In the outstanding office action, the Examiner rejected claims 1, 3, 9, 10, 11, 17, and 19 under 35 U.S.C. §103 as being unpatentable over U.S. Patent No. Des. 347,900 to Stapleton (the "Stapleton" reference) in view of U.S. Patent No. Des. 417,513 to Blanpied (the "Blanpied" reference). Further, the Examiner rejected claims 2, 4-6, 8, 12, 13, 15, 16, 18, 20, 21, 22 and 24 under 35 U.S.C. §103 as being unpatentable over Stapleton in view of U.S. Patent No. 6,014,847 to Phillips (the "Phillips" reference). Applicant requests reconsideration in light of the following remarks, withdrawal of the outstanding rejections, and allowance of the claims.

As pointed out in the previous response, the Examiner has failed to establish a *prima facie* case of obviousness since the applied references fail to teach or suggest all the claim limitations. The Examiner has admitted that the combination of Stapleton and Blanpied fails to include one of the elements of Applicant's claims, namely the provision that each tab is substantially uniform in color. The Examiner states that this element is not critical to the invention, and is merely a design choice. Making each of the tabs substantially uniform in color is viewed by the Examiner as being merely for aesthetic reasons since the limitation has to do with color, and therefore is not critical to the invention.

In a telephone interview between Examiner Steve Varner and Applicant's attorney Ted C. Gillespie on April 15, 2002, the Examiner stated that it would be an obvious design choice to choose colors for a product to make the product more closely resemble a desired object, regardless of whether or not the resemblance allowed the manufacturer to achieve an economic benefit. The Examiner stated that the missing element that is not found in the combination of the Stapleton and Blanpied references, i.e., the substantial uniformity of the coloration of the tabs, is of no patentable consequence because it is merely a matter of aesthetics, which are not deemed to be critical

to patentability. The Examiner stated that *Span-Deck, Inc. v. Fab-Con, Incorporated et al.*, 215 USPQ 835, and *In re Dailey and Eilers*, 149 USPQ 47 supported his position.

Applicant contends that he has shown criticality for the limitation pertaining to the substantially uniform coloration. Applicant recognizes that color is usually an aesthetic attribute of a product. However, as explained in great detail in Applicant's previous response, making each of the tabs substantially uniform in color has a significant utilitarian, functional value. * Applicant is not merely picking a color, such as orange or blue for the shingles in order to achieve an aesthetically pleasing appearance or in order to mimic the color of some other type of roof covering, but is rather specifying that the * color of the tabs must be generally uniform. Substantially uniformly colored tabs are the heart and soul of the present invention because without substantially uniformly colored tabs, the asphalt shingles would not look like slate tiles, and therefor could not command a premium price as a substitute for * a slate roof. The crucial change in structure of the shingles of the present invention when compared with the prior art is that the shingles of the present invention exhibit a substantially uniform color, not for the sake of being any particular color, but merely for the uniformity of the color. Applicant is not * merely changing shape or form, as was the situation in the Span-Deck case above. Further, Applicant is not faced with a situation where the two references combine to teach the entire invention, as was the situation in the case of *In re Dailey and Eilers*, above. Here, the references when combined still fail to meet all the limitations of Applicant's claims.

Applicant invites the Examiner's attention to the fact that there are many recently issued patents in the field of asphalt roofing products that use coloration or shading as a critical element. One such example is U.S. Patent No. 5,426,902 to Stahl et al., a reference of record, which discloses and claims shingles having various zones of different shading levels, some zones being

darker and some zones being lighter in shading. The purpose of the darker and lighter shading is give the shingle a perception of depth. This is a utilitarian purpose. The specification, at column 3, lines 40-47, also states that the zones can be of different colors rather than different shades. This is just one example of many illustrating the fact that the Patent and Trademark Office routinely takes into consideration matters of shading and color when assessing patentability of inventions.

In view of Applicant's showing of criticality, i.e., utilitarian value, of the substantially uniformly colored tabs, the Examiner has failed to make a *prima facie* case of obviousness under 35 U.S.C. §103(a). Accordingly, Applicant requests withdrawal of the rejections, and allowance of all claims.

In conclusion, Applicant has shown that the rejection of independent claims 1, 9 and 17 fails to make a *prima facie* case of obviousness under 35 U.S.C. §103(a), and therefore those claims and all claims dependent on those claims are patentable. Accordingly, Applicant respectfully requests reconsideration and withdrawal of the rejections of record, and allowance of all claims.